

### REMARKS

#### Double Patenting Rejection under 35 USC §101

Claims 1-6 stand rejected under 35 USC §101 as claiming the same invention as that of claims 1-6 of prior US Patent No. 6,811,720.

Applicants' claim 1 recites a "heat transfer element [that] consists essentially of a high heat transfer medium" made in a specific fashion. The claims of U.S. Patent No. 6,811,720 recite instead a "heat transfer element comprising a high heat transfer medium" made in a specific fashion. The two sets of claims do not recite the same patentable subject matter.

The Examiner's attention is brought to *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982) where claim sets of scope similar to those in issue here were reviewed by the Court. The set in the appealed patent application was considered not to have been properly rejectable under 35 USC 101.

Withdrawal of the rejection under 35 USC 101 is requested.

#### Double Patenting Rejection under Doctrine of Obviousness-type Double Patenting

Claims 7-283 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-16 of US Patent No. 6,811,720. The Examiner notes:

"The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A heat transfer element comprising a high heat transfer medium, wherein the high heat transfer medium is formed by dissolving the following compounds in water to produce a mixture, and drying the resulting mixture to produce said heat transfer medium product with said compounds in the following weight percentages: (1) Cobaltic Oxide (Co<sub>2</sub>O<sub>3</sub>), 0.5-1.0%; (2) Boron Oxide (B<sub>2</sub>O<sub>3</sub>), 1.0-2.0%; (3) Calcium Dichromate (CaCr<sub>2</sub>O<sub>7</sub>), 1.0-2.0%; (4) Magnesium Dichromate (MgCr<sub>2</sub>O<sub>7</sub>·6H<sub>2</sub>O), 10.0-20.0%; (5) Potassium Dichromate (K<sub>2</sub>Cr<sub>2</sub>O<sub>7</sub>), 40.0-80.0%; (6) Sodium Dichromate (Na<sub>2</sub>Cr<sub>2</sub>O<sub>7</sub>), 10.0-20.0%; (7) Beryllium Oxide (BeO), 0.05-0.10%; (8) Titanium Diboride (TiB<sub>2</sub>), 0.5-1.0%;

(9) Potassium Peroxide ( $K_2O_2$ ), 0.05-0.10%; (10) A selected metal or ammonium Dichromate ( $MCr_2O_7$ ), 5.0-10.0%; where "M" is selected from the group consisting of potassium, sodium, silver, and ammonium, (11) Strontium Chromate ( $SrCrO_4$ ), 0.5-1.0%; and, (12) Silver Dichromate ( $Ag_2Cr_2O_7$ ), 0.5-1.0%, the heat transfer medium is positioned on a substrate. The claims differ in the intended use for the heat transfer element. The applicant claims the heat transfer applicant [sic - element?] and not a method for using the element, therefore the intended use has not been given patentable weight.

"Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent."

Applicants will consider filing a Terminal Disclaimer under 37 CFR 1.321 (c) upon indication of all of the claims being otherwise allowable.

**CONCLUSION**

Applicants have responded to each matter of substance raised in the Office Action. Each of the presently pending claims is in condition for allowance. The Examiner is requested to withdraw the outstanding rejections and to pass this application to issue. If a telephone conference would expedite the prosecution of this application, the Examiner is urged and invited to telephone the undersigned attorney.

In the event the U.S. Patent and Trademark Office determines that an extension or other relief is required, applicants petition for any such relief including necessary extensions of time and authorizes the Commissioner to charge the cost of such petitions and other fees that may be due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 458172000300. However, the Commissioner is not authorized to charge the cost of the Issue Fee to the Deposit Account.

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Respectfully submitted,

By E. Thomas Wheelock

E. Thomas Wheelock

Registration No.: 28,825

MORRISON &amp; FOERSTER LLP

755 Page Mill Road

Palo Alto, California 94304

(650) 813-5739